REMARKS

In the above amendment, Applicant amends the claims to revise Claim 18, and to add new Claims 25-28. Claims 1-17, 20-21 and 23 are canceled, without prejudice.

Claim 18 amends the step of "editing and storing," to recite operations of the computer data management program and storage of the data both in the computer and in the mobile communication terminal. Support for this amendment may be found throughout the specification, and particularly at page 8, lines 5-15, and in Figures 9(a) and ((b). The "receiving step" is also amended to provide for storage of the data in the mobile communication terminal. Support for this amendment is found in the specification and, particularly, in Figure 9(b).

Claims 25-28 have been added in lieu of Claims 1, 4, 7 and 8, and merely clarify the method steps present in these former claims. As such, support for the new claims may be found in original Claims 1, 4, 7 and 8, and elsewhere throughout the specification.

Claims 1-9 were rejected under 35 U.S.C. Section 103(a) as unpatentable over the disclosure of U.S. Patent No. 5,046,082 ("Zicker"), in view of the disclosure in U.S. Patent No. 5,377,326 ("Murata"). Claims 10-24 were rejected under 35 U.S.C. Section 103(a) as unpatentable over the disclosures of Zicker in view of Murata and further in view of the disclosure of U.S. Patent No. 5,603,084 ("Henry, Jr."). Given the amendments and new claims presented, Applicant believes the present claims are patentable over the cited combinations of patents, and urges reconsideration and/or withdrawal of the rejections.

Zicker discloses use of a unique identifying signal to communicate between remotely accessible cellular telephones (RACTs) and a host system. The unique signal is disclosed as "not commonly found in the conventional data communication traffic." Indeed, the

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RACT programming method is described as including processes "so that remote accessibility features do not impact conventional operation of a cellular telephone." (Abstract).

Murata discloses an electronic apparatus, such as an electronic organizer, electronic memo or data book, which can transmit stored data to be stored in the memory of another electronic apparatus. (Field of the Invention) Transmission of data involves selection of either an "add" mode or an "update" mode instructing storage of the data in the receiving electronic apparatus, for instance, whether to preserve or replace previously stored data. (See Summary of the Invention, Column 2, lines 10-17). The Examiner cites Murata for ostensibly disclosing transmission of data using an update data mode, which the Examiner admits is absent in Zicker.

Henry Jr., in relevant part, discloses a TCP/IP link between a messaging center and an activation center, being separate units in a cellular system. (Column 8, line 65, to Column 9, line 3).

Claims 1-9 have been canceled. With respect, however, to new Claims 25-28, Applicant submits these are patentable over the asserted combination of Zicker and Murata for the reasons which follow.

Zicker is asserted as the primary reference. Although the Examiner concedes that Zicker fails to disclose the specific "updating and modifying of information" as claimed, Applicant further points out that Zicker also fails to disclose either the host or cellular telephone entering a specific mode, e.g., remote data update mode, as claimed. Consequently, there is no disclosure of executing a data manager program, along with entering a data update mode, for data to be received from or transmitted to the cellular phone. Thus, Zicker lacks sufficient disclosure

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to teach or suggest the elements of Applicant's claims, even considering what the Examiner admits is not present in Zicker.

Applicants also point out that in its claims, the step of entering the data update mode is directed to the transmission or receiving of data. In Murata, the mode is an instruction regarding the particular data structure and how it should be accommodated in whatever storage memory area, e.g., by adding it or replacing data. As claimed, a cellular phone entering the update data mode deviates from its voice communication service to transmit or receive data. The devices disclosed by Murata apparently have no voice communication dimension, nor do they need to "enter" or deviate from any other communication mode, rather the devices in Murata are small size data storage devices, not operational voice communication systems. Thus, the data transmitted by the method of Murata may include "telephone data", i.e. telephone numbers, but this is only a type of informational data, and not disclosed as data operating, modifying or editing any voice or other communication connection which is also performed by the apparatus. As such, Murata and its disclosure is inapposite to Applicants new claims 25-28. As such, and given the deficiencies in Zicker, combination of Murata with Zicker does not reach the elements and limitations of Applicants' claims.

With respect to Claims 10 -24, Claims 10-17, and 20, 21 and 23 have been canceled. Claim 18 has been amended as described and the Claims 19, 22 and 24 remain dependent upon Claim 18. Applicant submits that Claim 18, as amended, is patentable over the asserted combination of Zicker in view of Murata and further in view of Henry Jr. for the reasons which follow.

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Henry Jr. is cited as disclosing "cellular updating with IP protocol" Applicants have previously referenced the deficiencies in the disclosures of Zicker and Murata which fail to reach the elements of limitations of Applicants claims, many of which also appear in method steps recited in Claim 18, and therefore in all claims dependent thereon. Applicants, however, further point out that the relevant description in Henry Jr. apparently relied upon by the Examiner is to a X.400 protocol running on top of a TCP/IP linking an activation center and a messaging center, which are identified as "separate units within the cellular system", and is not disclosed as linking the radiotelephone and the cellular system. (See Column 8, line 65 to Column 9, line 3). This disclosure in Henry Jr. does not meet the elements and steps of Claim 18.

Applicant submits the above deficiencies demonstrate the cited patents do not support the Examiner's reasoning as to the asserted obviousness. Moreover, the failure of these patents to account for all of the elements and limitations recited in each of the Applicants remaining and added claims, demonstrate that the asserted combination of these patents do not render the claims obvious.

Additionally, and as to each of the rejections asserted relating to the combination of Zicker and Murata and Zicker, Murata, and Henry Jr., Applicants also point out that these are improper because the Examiner has neither cited, referenced or pointed to any motivation, teaching or suggestion in any of the patents for combining them in the manner relied upon to support the rejections. It is well settled that in order to establish a *prima facie* case of obviousness, each of the references cited must teach every element recited in the claims and identify the necessary motivation to combine these elements. *In re Rouffet,* 149 F. 3d 1350; 47

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USPQ2d 1453 (Fed. Cir., 1998). The rejections do neither, they therefore fail in making a *prima facie* case of obviousness and thus meeting the Examiner's burden.

The Examiner presents the citations by selecting features from each, *ad hoc*, to meet the Applicants' claims. Obviousness is said to arise because the features either "are well known" or because, in the Examiner's opinion, "they are functional equivalents" to those which are claimed. No facts support these assertions, however. And nothing supports one of ordinary skill in the art combining the dual tone RACT system of Zicker with the method of data storage intended for electronic memos and books in Murata. Indeed, no facts or evidence demonstrate such combination would be effective, desirable, or that it would be expected to yield that which Applicant has claimed. Placed upon this clearly uncertain foundation, citing Henry Jr. adds nothing to demonstrate any teaching, suggestion or motivation to modify any of the method disclosed in Zicker or Murata according to the disclosure of Henry Jr. Indeed, in the context of the rejection, employing a TCP/IP link between a activation center and a messaging center seems not at all germane to the methods of either Zicker or Murata.

Desirability of the asserted combination has not been adequately considered or addressed in the rejections. Hence, the assertion of obviousness is induced by mere unsupported opinion as to "equivalence" or the level of skill in the art, and is not deduced from the citations themselves and their disclosures, as is required. The Examiner's rationale, therefore, fails to support a *prima facie* case, even if the cited patents disclosed all elements and limitations of Applicants' claims, which they do not. As such, Applicants respectfully request reconsideration and withdrawal of the rejection.

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CONCLUSION

For the reasons heretofore discussed, favorable consideration and allowance of all

claims, as originally presented, and as added or amended, is respectfully solicited.

Respectfully submitted,

By: _____

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